

REMARKS

The Office Action dated May 4, 2007 contained a final rejection of claims 1-17. The Applicants have amended claims 1, 2, 4-7, 10 and 12-15. Claims 1-17 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1, 2, 4, 7-10, 12 and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Chang et al. (U.S. Patent Publication No. 2002/0083121) in view of Stecyk et al. (U.S. Patent Publication No. 2002/0171763). The Office Action also rejected claims 3, 5-6, 11 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over Chang et al. in view of Stecyk et al. and further in view of Kikugawa (U.S. Patent Publication No. 2003/0189644).

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

Namely, the independent claims now include features that are not disclosed by the combined cited references, alone or in combination. For instance, claims 1 and 7 now include a kiosk operating as one of the external devices, which communicates identifying information to a digital camera operating as the system that identifies the kiosk and its capabilities, and in response, the digital camera configures with icons the share menu according to the capabilities of the kiosk and shows the user specific capabilities that cannot be performed by the kiosk by graying out from the share menu intended actions that cannot be performed by the kiosk. Also, a device configuration module of the digital camera configures a customized kiosk device driver for the kiosk so that the kiosk can communicate its capabilities directly to the digital camera by way of specific kiosk device identifying information.

Moreover, claim 15 now includes initiating a connection between the digital camera, the external PDA device and a kiosk, and causing a selected task or action to be performed on the external PDA device and the kiosk in a preprogrammed manner, wherein the customizable displayable sharing means shows the user specific capabilities that cannot be performed by the external PDA device and the kiosk by

graying out from the share menu intended actions that cannot be performed by the external PDA device and the kiosk. Also, a device configuration module is included that configures a customized device driver for the external PDA device and the kiosk so that the external PDA device and the kiosk can communicate their respective capabilities by way of specific device identifying information of the PDA device and the kiosk.

In contrast, regarding the rejections of claims 1, 2, 4, 7-10, 12 and 15-17, although Chang et al. receive at the information apparatus over the communication channel attributes corresponding to the output device and Stecyk et al. include building a device list and device connection database, the combined cited references are clearly missing the above features of the Applicants' claimed invention. Next, regarding the rejection of the remaining claims, Kikugawa does not add anything to Chang et al. and Stecyk et al. that would render the claimed invention obvious. For instance, Kikugawa simply disclose providing electronic equipment which is provided with both radio interface and cable interface with automatic selection and connection with small power consumption without forcing an operator to be aware of an interface to be connected with external connection equipment (see Abstract and Summary of Kikugawa).

Specifically, regarding claims 1-14, the combined cited references are missing the claimed kiosk which communicates identifying information to the digital camera for identifying the kiosk and its capabilities, configuring the share menu with icons according to the capabilities of the kiosk and showing user specific capabilities that cannot be performed by the kiosk by graying out from the share menu intended actions that cannot be performed by the kiosk. In addition, the combined cited references are unquestionably missing the claimed device configuration module of the digital camera for configuring a customized kiosk device driver for the kiosk so that the kiosk can communicate its capabilities directly to the digital camera by way of specific kiosk device identifying information.

Regarding claim 15, the combined cited references are missing the claimed communication between the digital camera, the external PDA device and a kiosk, and causing a selected task or action to be performed on the external PDA device and the kiosk in a preprogrammed manner. Also, the combined cited references are missing the claimed device configuration module that configures a customized device driver for

the external PDA device and the kiosk so that the external PDA device and the kiosk can communicate their respective capabilities by way of specific device identifying information of the PDA device and the kiosk.

Thus, in light of the amendments to the claims, the cited references, alone or in combination, do not disclose all of the features of the claims. Therefore, the rejections of the claims under 35 U.S.C. § 103(a) should be withdrawn (MPEP 2143).

Further, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should not be considered together because Chang et al. teach away from the Applicants' claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Namely, Chang et al. clearly state that with implementations that do not provide a device driver, "...each application may have to implement its own device driver or its own output and communication capability, as described below with reference to FIGS. 3B and 3C. For example, to output a digital document to a printer, each application may have to implement its own printer-specific driving, processing and/or communication capability." (see the Summary and paragraphs [0006] and [0048] of Chang et al.). As argued above, unlike the Applicants' claimed invention which includes a configuration module of the digital camera for configuring a customized kiosk device driver for the kiosk so that the kiosk can communicate its capabilities directly to the digital camera by way of specific kiosk device identifying information, Chang et al. **explicitly** disclose that **"...each application may have to implement its own device driver or its own output and communication capability..." [emphasis added]** (see FIGS 3A and 3B and paragraphs [0006] and [0048] of Chang et al.).

Consequently, the proposed modification or combination would render Chang et al.

being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Chang et al. being modified because Chang et al. explicitly **cannot** use a configuration module of the digital camera for configuring a customized kiosk device driver for the kiosk so that the kiosk can communicate its capabilities directly to the digital camera by way of specific kiosk device identifying information, like the Applicants' claimed invention.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicants' claimed elements are **not** disclosed, taught or suggested by the combined references and because Chang et al. **teach away** from the Applicant's invention, Chang et al. **cannot** be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejections should be withdrawn. *MPEP 2143*.

Also, the Examiner is reminded that these references **should not** be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this teaching away and the failure of the cited

Serial No.: 10/686,854
Attorney Docket No.: 100110606-1

references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly requests the Examiner to telephone the Applicant's attorney at (818) 885-1575.

Please note that all mail correspondence should continue to be directed to

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

Respectfully submitted,
Dated: August 4, 2007



Edmond A. DeFrank
Reg. No. 37,814
Attorney for Applicant
(818) 885-1575 TEL
(818) 885-5750 FAX